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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/470,467	12/22/1999	ROBERT F. MARGOLSKEE	AP-32225-070	6178

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EXAMINER

JONES, DAMERON LEVEST

ART UNIT

PAPER NUMBER

1616

DATE MAILED: 05/22/2002

#8

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/470,467	<b>Applicant(s)</b> MARGOLSKIE ET AL.	
	<b>Examiner</b> D. L. Jones	<b>Art Unit</b> 1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 March 2002.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-63 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-18 is/are allowed.
- 6) ☒ Claim(s) 19-31, 34, 37, 39-41, 44, 47, 49-52, 55, 58 and 60-63 is/are rejected.
- 7) ☒ Claim(s) 32, 33, 35, 36, 38, 42, 43, 45, 46, 48, 53, 54, 56, 57, and 59 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
 If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) ☐ All b) ☐ Some \* c) ☐ None of:  
 1. ☐ Certified copies of the priority documents have been received.  
 2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
 \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
 a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____    | 6) <input type="checkbox"/> Other: _____                                    |

Art Unit: 1616

## **ACKNOWLEDGMENTS**

1. The Examiner acknowledges receipt of Paper No. 7, filed 3/12/02, wherein claims 1, 12, 19, 26, and 63 were amended.

**Note:** claims 1-63 are pending.

## **RESPONSE TO APPLICANT'S AMENDMENT/ARGUMENTS**

2. The Applicant's arguments/amendment filed 3/12/02 (Paper No. 7) to the rejection of claims 1-31, 34, 37, 39-41, 44, 47, 49-52, 55, 58, and 60-63 made by the Examiner under 35 USC 103 and/or 112 have been fully considered and deemed persuasive-in-part for the reasons set forth below.

### **112 Rejections**

The 112 rejection is WITHDRAWN for reasons of record in Applicant's response.

### **103 Rejections**

I. The 103(a) rejection of claims 1-18 is WITHDRAWN for reasons of record in Applicant's response. In particular, Applicant's argument that the cited prior art failed to disclose a crucial aspect of the present invention, that adenosine monophosphate and its structural homologs inhibit bitter tastant mediated G-protein activation, is found persuasive.

II. The rejection of claims 19-31, 34, 37, 39-41, 44, 47, 49-52, 55, 58, and 60-63 is as being unpatentable under 35 USC 103(a) over McLaughlin et al (1993, Ciba Foundation Symposium, Vol. 179, pages 186-200) in view of Naim et al (1994, Biochem. J., Vol. 297, pages 451-454), Ruiz-Avila et al (1995, Nature, Vol. 376, pages

Art Unit: 1616

80-85), Spielman (1998, J. Dent. Res., Vol. 77, No. 4, pages 539-544) and Boughter et al (1997, The Journal of Neuroscience, Vol. 17, No. 8, pages 2852-2858) is MAINTAINED for reasons of record in the Office Action mailed 11/8/01, Paper No. 5, and those set forth below.

Applicant asserts that the claims are distinguished over the cited prior art because the crucial aspect of the instant invention, that adenosine monophosphate and its structural homologs inhibit bitter tastant mediated G-protein activation, is not present in the prior art.

As stated above, Applicant's argument is found persuasive (see section I above) because the prior art neither anticipates nor renders obvious AMP or structural homologs thereof. However, independent claims 19, 26, and 63 disclose a test inhibitor, but do not contain the limitation that the test inhibitor is structural homolog of adenine monophosphate as in independent claims 1 and 12. Thus, it should be noted that in the other method and compositions claims wherein the bitter inhibitor is AMP are non-obvious over the prior art because the methods have different steps from that of independent claims 1 and 12 over which Applicant's arguments were found persuasive. Likewise, the composition claims which do not include AMP or structural analogs thereof still read on the cited prior art. Applicant is reminded that for composition claims, the intended utility and steps involved in order to use the composition for that particular utility are not given patentable weight.

Art Unit: 1616

### **ALLOWABLE CLAIMS**

3. Claims 1-18 are allowable over the prior art of record. In particular, the claims were found distinguished over the prior art for the reasons set forth in Applicant's response filed 3/12/02, Paper No. 7.

### **CLAIM OBJECTIONS**

4. Claims 32, 33, 35, 36, 38, 42, 43, 45, 46, 48, 53, 54, 56, 57, and 59 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

**Note:** The claims are objected to for reasons of record in the Office Action mailed 11/8/01, Paper No. 5.

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

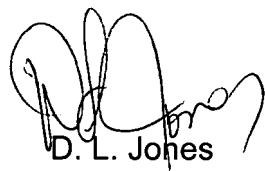
Art Unit: 1616

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. L. Jones whose telephone number is (703) 308-4640. The examiner can normally be reached on Mon.-Fri. (alternate Mon.), 6:45 a.m. - 4:15 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jose' Dees can be reached on (703) 308- 4628. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4556 for regular communications and (703) 308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.



D. L. Jones  
Primary Examiner  
Art Unit 1616

May 21, 2002